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LEGALFORCE RAPC WORLDWIDE

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LegalForce RAPC Worldwide, P.C.,
LegalForce Inc., and Raj V. Abhyanker

**UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION**

UNLIMITED JURISDICTION

<p>1. LEGALFORCE RAPC WORLDWIDE, P.C.;</p> <p>2. LEGALFORCE INC.; and</p> <p>3. RAJ V. ABHYANKER,</p> <p>Plaintiffs,</p> <p>v.</p> <p>1. TRADEMARKS INFORMATION INTERNATIONAL LLC.</p> <p>Defendant;</p> <p>AND DOES 1-50.</p>	<p>Case No. 5:17-cv-7354</p> <p>FIRST JOINT CASE MANAGEMENT STATEMENT & [PROPOSED] ORDER</p>
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Plaintiffs Legalforce RAPC Worldwide, P.C., Legalforce Inc., and Raj V.

1 Abhyanker (hereinafter, "Plaintiffs"), together with Defendant Trademarks
2 Information International LLC ("Trademarks411.com") ("Defendant") jointly
3 submit this JOINT CASE MANAGEMENT STATEMENT & PROPOSED
4 ORDER pursuant to the [Standing Order for All Judges of the Northern District](#)
5 [of California](#) and Civil [Local Rule 16-9](#).
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10 **1. Jurisdiction & Service**

11 Plaintiffs contend that: **(1)** This Complaint arises under the laws of the
12 United States, 15 U.S.C. §1125 et seq. **(2)** This Court has original jurisdiction of
13 this action under 28 U.S.C. §1331 because at least some of the claims alleged
14 herein arise under federal law. **(3)** This Court has supplemental jurisdiction
15 under 28 U.S.C. §1367 over any non-federal claims because such claims are so
16 related as to form part of the same case or controversy. All parties have been
17 served.
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19

20 **2. Facts**

21 Plaintiffs filed Complaint on **December 28, 2017**. The Plaintiffs ask
22 Defendant be enjoined from and pay damages for its unauthorized practice of
23 law, false advertising, unfair competition and other claims with respect to
24 preparation and filing of trademark applications before the USPTO. Plaintiffs
25 voluntarily dismissed certain individual defendants in their personal capacity on
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1 **February 9, 2018** to focus the issues in this case. On **February 27, 2018**,
2
3 Plaintiffs voluntarily dismissed the law firm of Rogers, Sheffield & Campbell,
4 LLP (RS&C) upon receiving declarations from the Managing Partner & Partner
5 of RS&C provided as **Exhibit 1** and **Exhibit 2** to the Notice of Voluntary
6 Dismissal filed that same day.
7

8 Defendant contends that: Trademarks411.com operates a website that
9 provides a user-friendly interface and transmission system for the general public
10 to prepare, and then file, their own trademark applications. Trademarks411.com
11 denies that it engages in the unlawful practice of law, unfair competition, or
12 fraudulent advertising.
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15 **3. Legal Issues**

16 Plaintiffs' and Defendant's Position: (1) Whether Plaintiffs have a private
17 right of action under the Federal Trade Commission Act; (2) whether Plaintiffs
18 have standing to sue under Cal. Bus. & Prof. Code § 17200, et seq.; (3) whether
19 Plaintiffs have standing to sue under Cal. Bus. & Prof Code § 17500, et seq.; (4)
20 whether Defendant Trademarks411.com is engaged in the unauthorized practice
21 of law; (5) whether Defendant Trademarks411.com unfairly competes against
22 Plaintiffs; (6) whether Defendant's conduct is the proximate cause of Plaintiffs'
23 harm; (7) whether Defendant Trademarks411.com engages in false advertising.
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27 **4. Motions**

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1 Plaintiffs' Position: Plaintiffs intend to file a motion for summary
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3 judgment at some point after discovery, as well as any other motions it deems
4 appropriate during the pendency of this litigation to be determined at a later
5 time.

6
7 Defendant's Position: Defendant Trademarks411.com intends to file a
8 motion to dismiss pursuant to Federal Rule of Civil Procedure, Rule 12(b)(6).

9
10 **5. Amendment of Pleadings**

11 Plaintiffs' Position: Plaintiff has no present intention to file an amended
12 complaint unless the motion to dismiss contemplated by the Defendant is filed
13 and granted by the court after objection.

14
15 **6. Evidence Preservation**

16 The Plaintiffs have reviewed the Guidelines Relating to the Discovery of
17 Electronically Stored Information ("ESI Guidelines"), and the parties have met
18 and conferred pursuant to Fed. R. Civ. P. 26(f) regarding reasonable and
19 proportionate steps taken to preserve evidence relevant to the issues reasonably
20 evident in this action per ESI Guidelines 2.01 and 2.02, and Checklist for ESI
21 Meet and Confer. Plaintiffs are willing to stipulate to submit to a third party
22 forensics company to preserve evidence with all meta-data intact with a proper
23 custodial chain if the Defendant agrees to do the same.

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27 Defendant's Response: Defendant has been advised of their duties and
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obligations with respect to the preservation of evidence. Defendant disputes that production of ESI metadata is necessary or relevant at this time.

7. Disclosures

The Plaintiffs have fully and timely complied with the initial disclosure requirements of Fed. R. Civ. P. 26 by providing a list of people and documents that have information supporting its case. Plaintiffs await initial disclosures from Defendant.

Defendant's Response: Defendant will make their initial disclosures on or before **March 1, 2018**, which is 14 days following the parties' Rule 26(f) conference, and the date by which such disclosures are due pursuant to Rule 26(a).

8. Discovery

Plaintiffs intend to depose RS&C, Nicholas Greenside, and Stephen Erickson, as well as seek discovery from Trademarks Information International LLC.

9. Class Actions

Not applicable at this time.

10. Related Cases

Defendant believes the following eight (8) cases, all in the Northern District to be related :

- a. LegalForce RAPC Worldwide P.C. et al v. MyCorporation Business Services, Inc. et al, 5:18-cv-00142-HRL, N.D. Cal., Judge: Hon. Howard R. Lloyd.
- b. LegalForce RAPC Worldwide P.C. et al v. Cheie et al, 5:18-cv-00127-HRL, N.D. Cal., Judge: Hon. Howard R. Lloyd, N.D. Cal., Judge: Hon. Howard R. Lloyd
- c. LegalForce RAPC Worldwide P.C. et al v. Demassa, 5:18-cv-00043-HRL, Judge: Hon. Howard R. Lloyd
- d. LegalForce RAPC Worldwide, P.C. et al v. Trademark Engine LLC et al, 5:17-cv-07303-LHK, N.D. Cal., Judge: Hon. Judge Lucy H. Koh
- e. Abhyanker et al v. Greenside et al, 5:17-cv-07354-BLF, N.D. Cal. Judge: Hon. Judge Beth Labson Freeman (instant case)
- f. Abhyanker et al v. FileMy, LLC et al, 5:17-cv-07331-NC, N.D. Cal. Judge: Hon. Nathanael M. Cousins
- g. LegalForce RAPC Worldwide P.C. et al v. Swyers et al, 5:17-cv-07318-NC, N.D. Cal. Judge: Hon. Judge Nathanael M. Cousins
- h. LegalForce RAPC Worldwide, P.C. et al v. LegalZoom.Com, Inc. et al, 3:17-cv-07194-MMC, N.D. Cal. Judge: Hon. Maxine M. Chesney

11. Relief

Plaintiffs' Response: Plaintiff has calculated its damages based on the

1 Defendant's estimated harm to its business through its estimated 3 year
2 trademark revenue through online advertising on Google, Bing, and/or other
3 search engines. Under the three causes of actions pled in the Complaint of
4 federal unfair competition, California unfair competition, and California false
5 and misleading advertising, the Plaintiff seeks temporary and permanent
6 injunctions as defined herein be entered in their favor and against Defendant,
7 enjoining operating any website that attempts to offer any legal services
8 requiring the practice of law including, but not limited to,
9 www.trademarks411.com for U.S. trademark filing and prosecution services for
10 trademark filings before the USPTO, office actions, statements of use,
11 oppositions, trademark watch, renewal, opposition, and litigation services.

12
13 The Plaintiffs seek this because further acts of false and misleading
14 advertising and unfair competition by the Defendant would damage or injure
15 Plaintiffs.

16
17 The Court find Trademarks411.com's acts of false and misleading
18 advertising and unfair competition to be knowing and willful, and an exceptional
19 case within the meaning of 15 U.S.C. §1117 and California law.

20
21 Restitution as allowed under applicable statutes.

22
23 Compensatory damages in an amount believed to be in excess of five
24 hundred thousand dollars (\$500,000.00) to be determined at trial. Plaintiffs'
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1 damages are continuing each day as they are unable to compete fairly due to
2 Defendant's unlawful actions, and they will seek treble recovery of all additional
3 damages they incur during the pendency of this lawsuit.
4

5 Punitive damages in an amount to be determined at trial.
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7 Legal and equitable further relief as this court finds just and proper.
8

9 Permanent exclusion from practice of law before the USPTO and the State
10 of California of Defendant Trademarks411.com and its member Stephen W.
11 Erickson.

12 Order compelling the USPTO to follow its stated procedures for
13 notification to affected applicants of an excluded marks for all trademarks in
14 which government fees were paid by the excluded party (**Exhibit X** of
15 Complaint) including, but not limited notifications to the affected applicant or
16 registrant that:
17
18

19 i. Trademarks411.com is not entitled to practice before the USPTO in
20 trademark matters and, therefore, may not represent the applicant or registrant.
21

22 ii. Any trademarks and documents filed by Trademarks411.com are
23 void ab initio, meaning they were invalid from the start of any action taken by
24 the excluded party.
25

26 iii. Trademarks411.com may not sign checkboxes, pay government fees,
27 prepare trademark applications, assist with responses to the USPTO's actions,
28

1 authorize examiner's amendments or priority actions, conduct interviews with
2 USPTO employees, or otherwise represent an applicant, registrant, or party to a
3 proceeding before the USPTO.
4

5 iv. All correspondence concerning the application or registration will be
6 sent to the domestic representative if one has been appointed, or, alternatively,
7 and in most circumstances, to the applicant or registrant at his/her address of
8 record.
9

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11 Plaintiffs be awarded costs, prejudgment interest and attorneys' fees
12 pursuant to 15 U.S. Code § 7706 of the Federal Trade Commission Act for
13 exceptional case, and other applicable statutes.
14

15 Defendant's Response: Defendant contends that none of the causes of
16 action pled allow for the recovery of damages.
17

18 **12. Settlement and ADR**

19 Plaintiffs have expressed their willingness to participate in an Early
20 Neutral Evaluation. Plaintiffs have expressed a preference for mediation.
21

22 Defendant's Position: Defendant has expressed their willingness to
23 participate in an Early Neutral Evaluation. Plaintiffs have expressed a preference
24 for mediation. However, Defendant contends that damages are not available and
25 Defendant contend that since they are of the belief that Plaintiffs seek to shut
26 down the Trademarks411.com website, it remains unclear to Defendant what
27
28

1 Plaintiffs would seek to accomplish through mediation.

2
3 **13. Consent to Magistrate Judge For All Purposes**

4 Defendant has filed a declination to proceed before a Magistrate Judge for
5 all purposes.

6
7 **14. Other References**

8 The parties agree that this case is not suitable for reference to binding
9 arbitration, a special master, or the Judicial Panel on Multidistrict Litigation.

10
11 **15. Narrowing of Issues**

12 The parties are working together collaboratively to narrow the issues by
13 agreement.

14
15 **16. Expedited Trial Procedure**

16 The parties agree that this is not the type of case that can be handled under
17 the Expedited Trial Procedure of General Order 64, Attachment A.

18
19 **17. Scheduling**

20 Plaintiffs would like to commence discovery at the earliest opportunity in
21 this case for depositions and requests for the production of evidence and tangible
22 things.

23
24 Defendant contends that no more than limited discovery should be
25 undertaken before the Court has ruled on their anticipated Rule 12(b)(6) motion,
26 particularly given Defendant's contention that Plaintiffs' claims implicate the
27 entirety of Trademarks411.com's business practices and communications with
28

1 its customers.

2
3 Defendant's Response: Defendant believes that only limited discovery
4 should proceed before the Court has determined the proper scope of Plaintiffs'
5 claims through the Rule 12(b)(6) motion process. Defendant does not request
6 any other modification to the discovery rules of the Federal Rules of Civil
7 Procedure. Should the case proceed to full discovery, Defendant anticipates
8 seeking discovery of Plaintiffs' claims, injury, and damages. The parties have
9 not agreed to an e-discovery stipulation.
10
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12 **18. Trial**

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14 Whether the case will be tried to a jury and the expected length of the trial
15 is 2 weeks.

16
17 Defendant's Position: The only remedies available to Plaintiffs on their
18 claims are equitable and cannot be heard by a jury. Defendant's expected length
19 of trial is three weeks.

20 **19. Disclosure of Non-party Interested Entities or Persons**

21
22 Each party has filed the "Certification of Interested Entities or Persons"
23 required by Civil Local Rule 3-15.

24
25 Pursuant to Civil Local Rule 3-15, the following entities and individuals
26 have minority equity stakes in the legal technology company Plaintiff
27 LegalForce, Inc. and are likely interested parties within the meaning of 28

1 U.S.C. § 455 referenced in Civil Local Rule 3-15 :

2
3 A. **Wilson Sonsini Goodrich & Rosati P.C.**, through the WS Investment
4 Company LLC.

5
6 B. **Roland Vogl**, Executive Director of CodeX: The Stanford Center for
7 Legal Informatics.

8
9 C. **Robert Barr**, former Chief Patent Counsel of Cisco Systems, Of Counsel,
10 Gunderson Dettmer, former Executive Director of Berkeley Boalt School
11 of Law, Center for Law and Technology.

12
13 D. **Daniel Katz**, Associate Professor of Law @ Illinois Tech – Chicago Kent
14 College and the Director of The Law Lab @ Illinois Tech.

15 E. **Carolyn Elefant**, Creator of ABA Top100 Blawg, MyShingle.com.

16
17 F. **Richard Granat**, Co-Chair of the eLawyering Task Force of the Law
18 Practice Management Section of the American Bar Association.

19
20 G. **Renee Knake**, Professor of Law and the Larry and Joanne Doherty Chair
21 in Legal Ethics, University of Houston Law Center (options unexercised,
22 anticipating exercise).

23
24 H. **Mitesh Patel**, Supervisor, Intellectual Property Clinic, Lincoln Law
25 School of California.

26 I. **Elizabeth Oliner**, Trademark Attorney on UpCounsel, Oliner Law.

27
28 J. **Jeffrey Drazan**, Bertram Capital, venture capitalist.

1 K. **Montgomery & Hansen LLP**, through M&H Advisors, LLC.

2
3 L. **Babar Rana**, former CEO of the former LegalForce, Inc. (LegalForce I)
4 and currently Program Manager of Google, Inc.

5 The undersigned certifies that as of this date, other than the named parties,
6 and those listed above, the undersigned believes there are no other interested
7 parties to report on behalf of LegalForce, Inc., LegalForce RAPC Worldwide
8 P.C., and Raj Abhyanker, collectively all Plaintiffs.
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11 Pursuant to Federal Rule of Civil Procedure 7.1 and Civil Local Rule 3-15,
12 Plaintiffs LegalForce, Inc. and LegalForce RAPC Worldwide P.C., by and
13 through their undersigned attorney, certify the following: LegalForce, Inc. and
14 LegalForce RAPC Worldwide P.C. has no parent corporation and no publicly
15 held corporation owns 10% or more of its stock.
16
17

18 Defendant's Response: The undersigned is counsel of record for Defendant
19 Trademarks Information International LLC. Pursuant to Civil L.R. 3-15, the
20 undersigned certifies that as of this date, other than the named defendant, there is
21 no such interest to report.
22

23 **20. Professional Conduct**

24 The attorney for the Plaintiffs has reviewed the Guidelines for Professional
25 Conduct for the Northern District of California.
26

27 Defendant's Response: Counsel for Defendant has reviewed the Guidelines
28

1 for Professional Conduct for the Northern District of California.

2
3 **21. Other**

4 Nothing at this time.

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6
7 By /s/ Raj V. Abhyanker February 27, 2018

8 Raj V. Abhyanker

9 California State Bar No. 233,284

10 Attorney for Plaintiffs:

11 LegalForce RAPC Worldwide, P.C.,

12 LegalForce, Inc., and

13 Raj V. Abhyanker

14 Christopher James Beal

15 California State Bar No. 216,579

16 Attorney for Defendant:

17 Trademarks Information International LLC
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CASE MANAGEMENT ORDER

The above JOINT CASE MANAGEMENT STATEMENT & PROPOSED ORDER is approved as the Case Management Order for this case and all parties shall comply with its provisions. [In addition, the Court makes the further orders stated below:]

IT IS SO ORDERED.

Dated:

UNITED STATES
DISTRICT/MAGISTRATE JUDGE

CERTIFICATE OF SERVICE OF
DOCUMENT OTHER THAN COMPLAINT

STATE OF CALIFORNIA, COUNTY OF SANTA CLARA

I am employed in the County of Santa Clara, State of California. I am over the age of eighteen years and not a party to the within action. My business address is 1580 W. El Camino Real Suite 10 Mountain View California.

On **February 28 2018**, I served the following document(s) described as **FIRST JOINT CASE MANAGEMENT STATEMENT & [PROPOSED] ORDER** on the interested parties in this action as follows:

SEE ATTACHED SERVICE LIST

☒ **BY CM/ECF NOTICE OF ELECTRONIC FILING:** I electronically filed the document(s) with the Clerk of the Court using the CM/ECF System. Participants in the case who are registered CM/ECF users will be served by the CM/ECF system. Participants in the case who are not registered CM/ECF users will be served by mail or by other permitted means.

☒ **BY U.S. MAIL:** I asked my assistant Astrid Schell via email to place the foregoing document(s) enclosed in sealed envelopes addressed as shown on the Service List. I am “readily familiar” with LegalForce RAPC Worldwide’s practice for collecting and processing correspondence for mailing with the United States Postal Service. Under that practice, it would be deposited with the United States Postal Service the same day in the ordinary course of

1 business. It is my understanding that such envelope(s) will be placed for
2 collection and mailing with postage thereon fully prepaid at Mountain View,
3 California, on that same day following ordinary business practices.
4

5 I declare under penalty of perjury under the laws of the State of United States
6 that the foregoing is true and correct.
7

8 Executed on **February 28, 2018**, at Mountain View, California.
9

10
11 LEGALFORCE RAPC WORLDWIDE P.C.
12

13 By /s/_____

14 Raj V. Abhyanker

15 California State Bar No. 233,284

16 Attorney for Plaintiffs:
17

18 LegalForce RAPC Worldwide, P.C.,

19 LegalForce, Inc., and

20 Raj V. Abhyanker
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SERVICE LIST
Abhyanker et al v. Greenside et al
5:17-cv-07354-BLF
Beth Labson Freeman, presiding

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